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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,842

01/18/2005

Gerhard Bonnet

PTK0025

8958

832

7590

12/20/2006

BAKER & DANIELS LLP
111 E. WAYNE STREET
SUITE 800
FORT WAYNE, IN 46802

EXAMINER

BRAINARD, TIMOTHY A

ART UNIT

PAPER NUMBER

3662

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/20/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/501,842	Applicant(s) BONNET ET AL.	
	Examiner Timothy A. Brainard	Art Unit 3662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>PTO-1449</u> . |

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely

exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation "...a width below 5%...", and the claim also recites "...preferably below 1%..." which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8-13, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al (US 6,856,723). Ito teaches of a frequency shifted feedback emission source characterized by the fact that a means is used to increase emission frequency component beat intensity (claims 1 and 2), the frequency shifted feedback characterized by the fact that the means to increase emission frequency component beat intensity configured as means for non-stochastic emission frequency component beat intensity increasing (claim 1), the frequency shifted feedback characterized by the fact that the means to increase emission frequency component beat intensity includes injection light source (claim 3), the frequency shift feedback characterized by the injection light source includes and injection laser (col 1, lines 65-67), the frequency shifted feedback characterized by the fact that the injection light source is configured to

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inject irradiation into the resonator of the frequency shifted feedback emission source for irradiating into the amplification medium (claim 3), the frequency shifted feedback emission source characterized by the fact that the injection light source is configured for irradiating of the appropriate intensity and/or phase of the injection light (US claim 8), the frequency sifted feedback emission source characterized by the fact that the injection light is configured for regular modulation of intensity and/or phase of the injection light (claim 8), the frequency sifted feedback emission source characterized by the fact that the injection light is configured to perform a periodic modulation of intensity and/or phase that changes with time (claim 7), the frequency sifted feedback emission source characterized by the fact that the injection light is configured so at least temporally one linear modulation frequency variation takes place (claim 7), the frequency sifted feedback emission source characterized by the fact that the injection light is configured so that a modulation lies in the magnitude order and/or close to the distances determined using the emission source and the given chirp rate from the frequency shifted feedback emission source is obtained (claim 9), the frequency sifted feedback emission source characterized by the fact that the frequency shifted feedback emission light source is a laser (col 1, lines 65-67), a process for operating a frequency shifted feedback emission light source characterized by the fact that the injection light source characterized by the fact that the beat intensity of the frequency components of the emitted irradiation are increased beyond what is achieved in a stationary condition through spontaneous emission (claims 1 and 2), the frequency sifted feedback emission source characterized by the fact that the injection light is configured to inject irradiation

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into the resonator of the frequency shifted feedback emission source specifically for irradiating into the amplification medium (claim 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (US 6,856,723). With respect to claims 6 and 20, Ito does not teach of the frequency sifted feedback emission source characterized by the fact that the injection light is configured for emission of irradiation of an irradiation frequency close to the upper or lower amplification threshold. It would have been obvious to modify Ito to include the frequency sifted feedback emission source characterized by the fact that the injection light is configured for emission of irradiation of an irradiation frequency close to the upper or lower amplification threshold because it is one of multiple design choices with no new or unexpected results. With respect to claim 7, Ito does not teach of the frequency shifted feedback emission source characterized by the fact that the injection light source for the irradiation of injection light is narrowband in reference to the amplification bandwidth of the frequency shifted feedback emission source specifically a width below 5%, preferably below 1% of the bandwidth of the amplification of the frequency shifted feedback emission source. It would have been obvious to modify Ito to include the frequency shifted feedback emission source characterized by the fact that

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the injection light source for the irradiation of injection light is narrowband in reference to the amplification bandwidth of the frequency shifted feedback emission source specifically a width below 5%, preferably below 1% of the bandwidth of the amplification of the frequency shifted feedback emission source because it would allow one to inject a light source that is close to only the frequency of interest.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito as applied to claim 1 above, and further in view of Nigham Jr et al (US 5,991,317). Ito does not teach of the frequency shifted feedback emission source characterized by the fact that an optical fiber is used internally in the resonator. Higham Jr teaches of the frequency shifted feedback emission source characterized by the fact that an optical fiber is used internally in the resonator. It would have been obvious to modify Ito to include the frequency shifted feedback emission source characterized by the fact that an optical fiber is used internally in the resonator because it is one of multiple design choices with no new or unexpected results.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito as applied to claim 1 above, and further in view of Phillips et al (5,835,199). With respect to claim 15, It does not teach of distance measurement configuration with an emission light source that is a frequency shifted feedback emission source characterized by the fact that a means is used to increase emission frequency component beat intensity. Phillips teaches of a distance measurement configuration with an emission light source that is a frequency shifted feedback emission source characterized by the fact that a means is used to increase emission frequency

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component beat intensity (col 1, lines 42-45). It would have been obvious to modify Ito to include a distance measurement configuration with an emission light source that is a frequency shifted feedback emission source characterized by the fact that a means is used to increase emission frequency component beat intensity because it is one of multiple design choices with no new or unexpected results. With respect to claims 16-17, Ito does not teach of the distance measurement characterized by the fact that irradiation optics are used to broadly illuminate a surface to be investigated with light from the emission source and a means is used to obtain a beat spectrum containing height profile information or a distance measurement characterized by the fact that an optic is used to direct irradiation from the emission light source to a defined partial range of the object. Phillips teaches of the distance measurement characterized by the fact that irradiation optics are used to broadly illuminate a surface to be investigated with light from the emission source and a means is used to obtain a beat spectrum containing height profile information or a distance measurement characterized by the fact that an optic is used to direct irradiation from the emission light source to a defined partial range of the object (col 37, lines 45-53). It would have been obvious to modify Ito to include the distance measurement characterized by the fact that irradiation optics are used to broadly illuminate a surface to be investigated with light from the emission source and a means is used to obtain a beat spectrum containing height profile information or a distance measurement characterized by the fact that an optic is used to direct irradiation from the emission light source to a defined partial range of the object because it is one of multiple design choices with no new or unexpected results.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection.

Claims 1-15, and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 10/501843. With respect to claims 1 and 15, although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of application 10/501843 anticipates claims 1 and 15 of the current application. With respect to claims 2-12, 14, and 20, although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of application 10/501843 anticipates claims 2-12, 14, 20 of the current application. With respect to claim 13, although the conflicting claims are not identical, they are not patentably distinct from

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each other because claim 3 of application 10/501843 anticipates claims 13 of the current application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 16 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/501843 in view of Phillips. Application number 10/501843 does not teach of the distance measurement characterized by the fact that irradiation optics are used to broadly illuminate a surface to be investigated with light from the emission source and a means is used to obtain a beat spectrum containing height profile information or a distance measurement characterized by the fact that an optic is used to direct irradiation from the emission light source to a defined partial range of the object. Phillips teaches of the distance measurement characterized by the fact that irradiation optics are used to broadly illuminate a surface to be investigated with light from the emission source and a means is used to obtain a beat spectrum containing height profile information or a distance measurement characterized by the fact that an optic is used to direct irradiation from the emission light source to a defined partial range of the object (col 37, lines 45-53). It would have been obvious to modify the application to include the distance measurement characterized by the fact that irradiation optics are used to broadly illuminate a surface to be investigated with light from the emission source and a means is used to obtain a beat spectrum containing height profile information or a distance measurement characterized by the fact that an optic is used to

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direct irradiation from the emission light source to a defined partial range of the object because it is one of multiple design choices with no new or unexpected results.

This is a provisional obviousness-type double patenting rejection.

Claim 19 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/501843 in view of Ito. Application No. 10/501843 does not teach of the frequency shifted feedback emission source characterized by the fact that the beat the injection light source is configured to inject irradiation into the resonator of the frequency shifted feedback emission source. Ito teaches of the frequency shifted feedback emission source characterized by the fact that the beat the injection light source is configured to inject irradiation into the resonator of the frequency shifted feedback emission source. It would have been obvious to modify the application to include the frequency shifted feedback emission source characterized by the fact that the beat the injection light source is configured to inject irradiation into the resonator of the frequency shifted feedback emission source because it is one of multiple design choices with no new or unexpected result.

This is a provisional obviousness-type double patenting rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy A. Brainard whose telephone number is (571) 272-2132. The examiner can normally be reached on Monday - Friday 8:00 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAB


THOMAS H. TARCZA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3662